

### REMARKS

Claims 1-23 are pending in the present application. Claims 1, 10-12, and 21-23 were amended. Reconsideration of the claims is respectfully requested. Applicants representative thanks the examiner for the telephone conference on June 23, 2003. In this telephone conference, the examiner agreed that the proposed amendments sent to the examiner would overcome the rejections based on *Moon* and *Klein*. In view of the telephone conference, these amendments are being sent with this Response to Office Action.

I. 35 U.S.C. § 103, Obviousness, Claims 1-2, 4, 10-13, 15, and 21-23

The examiner has rejected claims 1-2, 4, 10-13, 15, and 21-23 under 35 U.S.C. § 103 as being unpatentable over Moon, United States Patent Number 6,138,146 ("*Moon*") in view of Klein et al., United States Patent Number 6,496,853 ("*Klein*"). This rejection is respectfully traversed.

In rejecting the claims, the examiner stated:

In considering claims 1, 4, 11-12, 15, and 22, *Moon* discloses a system and method for processing an electronic mail message, the method comprising:

determining whether the electronic mail message for a recipient is to be forwarded to another address associated with the recipient (col. 7, lines 22-26);

While *Moon* discloses the system substantially as claimed, *Moon* does not expressly disclose the step of including an indicator identifying the electronic mail message as to be forwarded if the electronic mail message is to be forwarded to another address associated with the recipient. Nonetheless, using indicators to which one message is a response to another message (e.g. a reply to or a forwarding of) another message is well known as evidenced by *Klein*.

In the same field of endeavor, *Klein* discloses a system for managing related electronic messages that includes a message thread, which is a group of messages that are related to one another either by reply or forwarding. *Klein* also discloses wherein messages that are related to one another either by reply or forwarding. *Klein* also discloses wherein messages in the same message thread, share various common message information along with relation indicators such as "RE", which indicates a reply message, or "FW", which indicates a forwarded message (See *Klein* col. 1, lines 35-45). It is common of most e-mail clients to include such relation indicators that identify what types of e-mail message is being

received. Thus, given the teachings of Klein it would have been obvious to modify the system as disclosed by Moon to include the relation indicator taught by Klein in order to provide the recipient descriptive e-mail, that if forwarded; is indicated as such. Therefore, the claimed limitation would have been an obvious modification to the system disclosed by Moon.

Office Action dated March 26, 2003, pages 2-3.

The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this particular case, a *prima facie* case of obviousness has not been established based on the prior art in view of amendments to the independent claims.

Amended claim number 1 reads as follows:

1. A method in a data processing system for processing an electronic mail message, the method comprising:  
determining whether the electronic mail message for a recipient is to be forwarded to another address associated with the recipient; and  
including an indicator identifying the electronic mail message as being forwarded from an old address if the electronic mail message is to be forwarded to another address associated with the recipient.

Independent claims 11, 12, and 22 include similar features. In particular, the feature in which the indicator identifies an electronic mail message as being forwarded from an old mail address is not taught or suggested by *Moon* or *Klein* alone or in combination.

Amended claim number 10 reads as follows:

10. A method in a data processing system for forwarding an electronic mail message, the method comprising:  
receiving a signal to forward the electronic mail message to another address for a recipient; and  
including an indication in the electronic mail message that the electronic mail message is forwarded from an old address for the recipient.

Claims 21 and 23 also include similar features. Claim 10 includes a feature in which the indication is that the electronic mail message is forwarded from an old address for the recipient. Such a feature is not taught by either of the references alone or in combination.

In rejecting the claims, examiner pointed to the following portion of *Klein* as teaching an indicator:

A message thread is a group of messages that are related to each other, such as when one message is a response to (e.g., a reply to or a forwarding of) another message. Messages in the same message thread will typically share various common message information, such as related subjects or common message content. For example, a reply email or voicemail will often include the contents of the original message as well as additional contents specific to the reply, and the subject line of a reply or forwarded email will often include the original subject line along with a relation indicator such as "RE:" or "FW:" respectively.

*Klein*, col. 1, lines 35-45. As can be seen, this portion of *Klein* teaches including a relation indicator, such as "RE:" or "FW:", depending on whether the email message is being replied to or forwarded. Such an indication, however, does not include an identification of the email message being forwarded from an old address for the recipient. Further, no teaching, suggestion, or incentive is found for modifying the relation indicators in *Klein* to provide the identification feature in claim 1 or claim 10 in which an email message is identified as being forwarded from an old address. This type of indicator is not taught or suggested by either of the references alone or in combination. Thus, the indication or indicator feature of the present invention is not taught or suggested by these two references.

Further, even if such a feature could be, for sake of argument, found in the references, these two cited references cannot be combined as believed by the examiner. One of ordinary skill in the art would not be motivated to combine *Moon* and *Klein* when these references are considered as a whole. "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986).

Although both references may include forwarding messages, such a feature alone is insufficient to provide motivation to combine these two references. One cannot pick and choose from individual teachings within references, but the references as a whole must be considered. For example, in considering *Moon* and *Klein* as a whole, one of ordinary skill in the art would consider the problems recognized by these references in determining whether to combine them in the manner proposed by the inventor.

*Moon* is directed toward the following problem associated with email messages:

Generally, the TBP can access the private server through a dial up Public Switch Telephone Network ("PSTN") connection, or alternatively, from the Internet or other public network through the firewall router. Problems arise when the TBP is unable to access the private server via the Internet due to various network restrictions which may be placed on such connections by the business or corporation. The PSTN connection may require a long distance call.

An option has been to designate an address in a network external to the private network generally accessible to the public, i.e., a public mailbox resident in a public server, where E-mail messages are to be sent. However, this option lacks security in that the E-mail, while sitting at the public mailbox, may be improperly accessed and viewed and/or stolen by a non-intended party. Further, this option generally provides limited connectivity to internal corporate messages.

Often, a TBP would have a private or corporate mailbox in the private server and a personal mailbox in the public server. For convenience purposes, the TBP would normally want to keep corporate messages separate from personal messages. A way of accomplishing this is to have all corporate mail sent to the corporate mailbox. By providing both a personal and a corporate mailbox address, a TBP is unaware of where important corporate messages may be stored, and would thus have to check both mailboxes for messages, which may result in wasted time and money. Further, the addition of a personal mailbox address also increases the number of E-mail addresses that the TBP's correspondents must deal with.

*Moon*, col. 1, line 48- col. 2, line 10. *Moon* describes a problem associated with accessing email on a private server and a public server in which two addresses are provided. *Moon* recognizes that wasted time and money occurs with having to check both mailboxes for messages.

In contrast, *Klein* is directed toward the following problem:

A message thread is a group of messages that are related to each other, such as when one message is a response to (e.g., a reply to or a forwarding of) another message. Messages in the same message thread will typically share various common message information, such as related subjects or common message content. For example, a reply email or voicemail will often include the contents of the original message as well as additional contents specific to the reply, and the subject line of a reply or forwarded email will often include the original subject line along with a relation indicator such as "RE:" or "FW:" respectively.

Consider, for example, the following situation in which co-workers send a series of emails that are part of a single message thread back and forth to each other, and each response message contains the contents of the message being responded to as well as additional unique content. Worker A first sends message 1 to workers B and C and to supervisor D. Worker B responds to message 1 with response message 2 sent to A and D, and worker C responds to message 1 with a distinct response message 3 sent to A and D. Thus, supervisor D has received message 1, message 2 which includes the contents of message 1 as well as additional contents, and message 3 which includes the contents of message 1 as well as additional contents.

While message threads can provide various benefits, receiving message thread messages can also create various problems. For example, a recipient of multiple message thread messages will often receive multiple messages that include common content. In the example above, supervisor D received the contents of message 1 in three different messages. After the contents of message 1 has been received the first time (e.g., from receiving message 1), those contents become redundant for that message recipient when they are included in the contents of other received message thread messages (e.g., such as response messages 2 and 3).

Current mechanisms for managing pending messages for a user create problems with respect to message thread messages with redundant contents. Pending messages for a user include those messages which have been received but not yet reviewed, as well as those messages which have been reviewed and retained. When a user has received multiple messages that are part of a common message thread, current message management mechanisms store and present each such message to the user. However, when the pending messages for a user include messages with contents that are redundant in light of the contents of other pending messages, various inefficiencies result. For example, extra computer resources are needed for the storage and presentation of the redundant contents, and extra time is needed by the user to review each message and to determine what contents are new and what contents are redundant.

*Klein*, col. 1, line 34- col. 2, line 18. As can be seen, *Klein* is directed toward problems relating to managing pending messages in which some common or redundant content may be present.

As a result, one of ordinary skill in the art would not be motivated to combine these two references because they are directed toward different problems associated with different email messages. *Moon* is directed toward problems with having two mailbox

addresses for a private and public server, while *Klein* is directed toward problems in handling pending messages received at a single address.

Further, in considering *Moon* and *Klein* as a whole, these two references are directed towards vastly different solutions. *Moon* teaches the following mail forwarding system:

A mail forwarding system is provided for use in a private network having a server, a fixed computer and a router for connection to a public network external to the private network, all interconnected via a data connection, with the server controlling electronic mail resources when electronic mail addressed to a user of the fixed computer is received by the private network. The mail forwarding system includes a mail forwarding program operating in the fixed computer for controlling the fixed computer to selectively (a) retrieve electronic mail addressed to the user of the fixed computer from the private network and (b) transmit the received electronic mail via the router to an assigned address in the public network accessible by a communicator remote to the private network.

*Moon*, col.2, lines 16-29. As described, *Moon* teaches a mail forwarding system that forwards mail from a private network to a public network.

On the other hand, *Klein* teaches the following:

The present invention provides a method and system for managing messages so that messages with redundant contents need not be reviewed by a user. Techniques of the invention monitor electronic messages received by a user and determine whether the received electronic messages are related to pending electronic messages for the user, such as by being part of the same message thread. Messages with redundant contents among the related messages are then identified, and the messages with redundant contents are managed so that the user need not review the contents. The messages with redundant contents can be managed by creating a new message which includes the unique contents of each of the identified messages but at most a single copy of the redundant contents. After the new message is created, the identified messages used to create the new message can then be indicated to be redundant in light of the newly created message in one or more ways, such as by deleting the identified messages or by altering the visual indicators of the identified messages presented to the user. Alternatively, the messages with redundant contents can be managed by deleting the redundant contents from the identified messages, or by altering the manner in which the redundant contents are presented to allow for easy identification by the user.

*Klein*, col. 2, lines 21-44. As can be seen, *Klein* teaches a method for indicating redundancy in pending messages having redundant content.

Thus, these two references are directed toward different solutions when they are considered as a whole. *Moon* is directed toward a mail forwarding system between a private network and a public network, while *Klein* is directed toward a method and system for managing messages with redundant content.

Even if these two references could be combined as asserted by the examiner, the combination would not reach the presently claimed invention. A combination of these two references would result in a mail forwarding system in which mail may be selectively forwarded from a private network to an address in a public network, in which the forwarded messages include a relation indicator "FW:" to indicate that the message has been forwarded, as well as a message indicating redundant portions between different pending messages. However, the feature in which the indicator identifies the electronic mail message as being sent from an old email address would not be part of such a combination.

The other claims rejected are dependent claims depending from one of the independent claims. Therefore, these claims are patentable over *Moon* and *Klein* for the same reasons. Additionally, these claims include additional claims or features not taught or suggested by the cited references.

Therefore, the rejection of claims 1-2, 4, 10-13, 15, and 21-23 under 35 U.S.C. § 103 has been overcome.

## **II. 35 U.S.C. § 103, Obviousness, Claims 3, 5-9, 14, 16-20**

The examiner has rejected claims 3, 5-9, 14, and 16-20 under 35 U.S.C. § 103 as being unpatentable over *Moon*, in view of Berkowitz et al., United States Patent Number 6,088,720 ("*Berkowitz*") in further view of Fuisz et al., United States Patent Number 6,389,445 ("*Fuisz*"). This rejection is respectfully traversed.

These claims are patentable over these cited references because these claims are dependant claims depending from one of the independent claims rejected using *Moon* and *Klein*. These independent claims are patentable over the cited references for the reasons stated above. Adding additional references for other features in these dependant claims

does not render these dependant claims obvious since the independent claims are patentable. In particular, none of these cited references include an indicator that indicates that the electronic message has been forwarded from an old address.

Further, these claims also include other features not taught or suggested by the cited references. Specifically, the type or style of a forwarding indicator is not merely a design choice as asserted by the examiner. Although many types of indicators may be available, the particular types of indicators used in the claims are not merely design choices. Importantly, design choice is not the standard by which the claims are to be examined. Such an assertion is equivalent to saying it would be obvious to modify a feature because such a modification would be easy to make.

The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also see *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The examiner may not merely state that the modification would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification. Moreover, the examiner may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of applicant's disclosure. *Id.*

In this particular case, the appropriate standard is not design choice but whether the modification or combination would be obvious when these references are viewed as a whole by one of ordinary skill in the art. For example, *Moon* is directed toward a different problem from the other references in the proposed combination. *Mulligan* is directed toward problems associated with the arrival of messages when a recipient is not located at a location where the message is delivered or can be received. *Berkowitz* is directed toward problems when a user is unable to access an electronic mail message over an extended period of time after which the user's mailbox is filled with many messages in which some messages have lost value while other messages are still relevant. *Fulcz* is



directed toward problems associated with losing email messages after an account has been discontinued. *Iwasa* is directed toward user operability to forward messages to different destinations. As can be seen, all of these cited references are directed toward problems that are vastly different from those recognized by *Moon*. The solutions provided by each of these references are very different from *Moon*.

Therefore one of ordinary skill in the art would not be motivated to select features in a piecemeal fashion and combine them with *Moon* in the manner proposed by the examiner. Even if such a combination could be made, none of the references alone or in combination teaches or suggest using an indicator to identify an electronic mail message as being forwarded from an old address.

As a result, the rejection of claims 3, 5-9, 14, and 16-20 under 35 U.S.C. § 103 has been overcome.

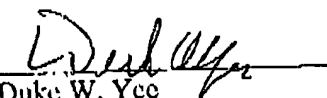
### III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if, in the opinion of the examiner, such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

  
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